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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
08/720,070	09/27/96	HYATT	R P53821C
			EXAMINER

PM92/0817

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BOUGHTER, D	PAPER NUMBER
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3627  
DATE MAILED:  
08/17/99

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

### OFFICE ACTION SUMMARY

☒ Responsive to communication(s) filed on August 6, 1999

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 8 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claims

- ☒ Claim(s) 1-59 is/are pending in the application.  
☐ Of the above, claim(s) 32, 33, 53, 55, 43-45 is/are withdrawn from consideration.  
☒ Claim(s) 1-24, 34-38, 57-59 is/are allowed.  
☒ Claim(s) 25-31, 39-42, 46-52, 54, 56 is/are rejected.  
☐ Claim(s) \_\_\_\_\_ is/are objected to.  
☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

#### Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.  
☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.  
☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.  
☐ The specification is objected to by the Examiner.  
☐ The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).  
☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.  
☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_  
☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

- ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

- ☒ Notice of Reference Cited, PTO-892  
☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_  
☐ Interview Summary, PTO-413  
☐ Notice of Draftsperson's Patent Drawing Review, PTO-948  
☐ Notice of Informal Patent Application, PTO-152

--SEE OFFICE ACTION ON THE FOLLOWING PAGES--

Art Unit: 3627

## **DETAILED ACTION**

### ***Election/Restriction***

This application contains claims directed to the following patentably distinct species of the claimed invention: Specie A, figures 3-4, species B, figures 5A-5B, Species C, figures 5C-5D, Species D, figures 6-7, Species E, figures 8A-8G, Species F, figure 8H, Species G, figures 13-15 . Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 46 appears generic.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CAR 1.143).

Since there is no indication in the CPA application that a change in election is desired, prosecution is being continued on the invention elected and prosecuted by the applicant in the

Art Unit: 3627

prior application. The species restriction was made in Paper No. 4 to which applicant elected Species E shown in Figures 8A-8G with traverse in Paper No. 6. Even though the Examiner gave action upon the patentability of the claims to some of the nonelected inventions during earlier prosecution of this application, the election is not waived. *Ex parte Loewenbach*, 1904 C.D. 170, 110 O.G. 857 (Comm'r pats 1904); and *In re Waugh*, 1943 C.D. 411, 553 O.G. 3 (CCPA 1943). Previous examination as to the patentability of nonelected inventions was an effort to place the case in condition for allowance. Applicant additional claims has increased the burden on the Examiner and therefore the restriction is being reinitiated.

In a telephone interview with the applicant's representative the Examiner stated that the election requirement would not be reinitiated only if the CPA application was in condition for allowance. Since the application is not in condition for allowance, the restriction requirement and applicant's election continues in this application.

Newly presented claims 32, 33, 53 and 55 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: claims 53 and 55 are drawn to a subcombination usable with the electronic key plug. The networking system of plural keys and plural locks does not need the particulars of the electronic locks claimed in applicant's various species and the broadly recited electronic lock of claim 46 has separate utility such as being used only with a single key on a single cabinet, safe, etc to be locked.

Newly presented claims 43-45 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Claims 43-45 do not appear to be

Art Unit: 3627

drawn to Species E. It is unclear to the Examiner what Species these claims are drawn to.

Appropriate explanation is required. It should be noted that in claim 43, "said aperture" lacks antecedent basis.

Since applicant has received an action on the merits for the originally presented invention of Species E, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim withdrawn from consideration as being directed to a non-elected invention. See 37 CAR 1.142(b) and MPEP § 821.03.

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 3627

2. Claims 25-31, 39-42, 46-52, 54,56 are rejected under 35 U.S.C. 102(e) as being anticipated or in the alternative obvious under 35 U.S.C. 103(a) over Gokcebay et al. 5,552,777. Gokcebay et al. teaches all the elements of the claimed invention including shell 20, cylinder plug 24, bar 38, electrical operator 48 which responds to a control signal by moving between a first and second different orientation providing obstruction of the bar. The first orientation is when the spring as a result of the small solenoid 36 being energized compresses and allows retraction of the bar 38. The second orientation is when the spring biases the bar outwardly to prohibit rotation of plug. Column 6, lines 38-45. The spring is considered electrically operable in that the spring may only move between its two orientations as a result of the control signals with energize and deenergize the solenoid. It is inherent in Gokcebay et al. that the second end of the cylinder lock is attached to some form of typical cam actuator (not shown). Also, Gokcebay et al. is a continuing application of Gokcebay et al. 5,367,293 which shows a bearing surface and cam actuator. Alternatively, it would have been obvious to provide a bearing surface for mounting a cam actuator to the lock cylinder of Gokcebay et al. since cam actuators are typical on rotatable plugs for locking the two surfaces together. With regard to claim 27, the Examiner takes OFFICIAL NOTICE that key retainers are well known. See Aston '042. It would have been obvious to one of ordinary skill in the art to add a key retainer to the device of Gokcebay et al. for maintaining the shank of the key within the plug during rotation. With regard to claims 28 and 50, it would have been an obvious duplication of part to have plural conductors borne by the lock to engage a circuit in the key.

Art Unit: 3627

*Allowable Subject Matter*

3. Claims 1-24, 34-38 and 57-59 are allowed.

*Conclusion*

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Darnell Boucher whose telephone number is (703) 308-2492. The examiner can normally be reached on Monday-Friday from 8:00 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Meyers, can be reached at (703) 308-3868.

Submission of your response by facsimile transmission is encouraged. Group 3620's facsimile number is **(703) 305-3597**. Recognizing the fact that reducing cycle time in the processing and examination of patent applications will effectively increase a patent's term, it is to your benefit to submit responses by facsimile transmission whenever permissible. Such submission will place the response directly in our examining group's hands and will eliminate Post Office processing and delivery time as well as the PTO's mail room processing and delivery time. For a complete list of correspondence **not** permitted by facsimile transmission, see MPEP § 502.01. In general, most responses and/or amendments not requiring a fee, as well as those requiring a fee but charging such fee to a deposit account, can be submitted by facsimile transmission. Responses requiring a fee which applicant is paying by check **should not be** submitted by facsimile transmission separately from the check.

Art Unit: 3627

Responses submitted by facsimile transmission should include a Certificate of Transmission (MPEP § 512). The following is an example of the format the certification might take:

I hereby certify that this correspondence is being facsimile transmitted to the Patent and Trademark Office (Fax No. (703) 305-3597) on \_\_\_\_\_(Date)\_\_\_\_\_

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(Typed or printed name of person signing this certificate)

\_\_\_\_\_  
(Signature)

If your response is submitted by facsimile transmission, you are hereby reminded that the original should be retained as evidence of authenticity (37 CAR 1.4 and MPEP § 502.02). Please do not separately mail the original or another copy unless required by the Patent and Trademark Office. Submission of the original response or a follow-up copy of the response after your response has been transmitted by facsimile will only cause further unnecessary delays in the processing of your application; duplicate responses where fees are charged to a deposit account may result in those fees being charged twice.

Any inquiry of a general nature relating to the status of this application should be directed to the group receptionist at (703) 308-2168.

August 16, 1999